

Attachment H

IN UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Douglas Wilson

Examiner: Vinh Luong

Serial No.: 10/727,306

Art Unit: 3656

Filing Date: December 3, 2003

For: FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS AND THE LIKE

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

AMENDMENT AFTER FINAL ACTION PURSUANT TO 37 C.F.R. §1.116

SIR:

INTRODUCTORY COMMENTS

This Amendment/Response (“Amendment”) responses to the Office Action dated May 13, 2010 that finally rejected the pending claims 14-19, 24, and 27. In this Amendment, Applicant traverses each and every basis upon which the Examiner has objected to Specification and rejected the pending claims 14-19, 24, and 27. Accordingly, the present application is in condition for allowance:

Applicant also files herewith a Notice of Appeal.

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are set forth in a listing of the claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 6 of this paper.

IN THE SPECIFICATION:

Please replace paragraphs [0019] and [0025] with the following amended paragraphs:

[0019] Deformable material 102 extends outward from the steering control 105 over a predetermined section of the steering control which is shown in FIG. 1 to be an arc. Deformable second section 102 may extend outwardly from the steering control at or below the inside circumference of the control over the predetermined arc. This arc will typically include at least the ten 104 and two 106 o'clock positions, or may include the entire circumference. As shown in FIG. 1, the arc that covers the ten 104 and two 106 o'clock positions is disposed on the upper one-half ($\frac{1}{2}$) of steering control 105.

[0025] In FIG. 2, system 202 is at or near the ten o'clock position and system 203 is shown at or near the two o'clock position. As shown in FIG. 2, system 202 that is at or near the ten o'clock position and system 203 that is at or near the two o'clock position are disposed on the upper one-half ($\frac{1}{2}$) of steering control 211. Although, the two systems have been described as being positioned at the ten and two o'clock locations, it is understood that they may be placed at other locations around the rim and there may be more than two systems and still be within the scope of the present invention.

IN THE CLAIMS:

1-13. (Cancelled)

14. (Previously Amended) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle, comprising:

a first section that connects to an upper one-half (1/2) of a peripheral portion of the steering wheel; and

a rigid, semi-rigid or flexible, or deformable second section that connects to, and extends from the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a front face of the steering wheel, the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

15. (Previously Presented) The apparatus as recited in claim 14, wherein the steering wheel includes the steering wheel for controlling at least a nautical vessel, aircraft, or ground transportation vehicle.

16. (Previously Presented) The apparatus as recited in claim 14, wherein the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

17. (Previously Presented) The apparatus as recited in claim 14, wherein the first section extends a predetermined length of the peripheral portion of the steering wheel.

18. (Previously Presented) The apparatus as recited in claim 14, wherein the second section includes at least two second sections that each connect to the first section at separate locations.

19. (Previously Presented) The apparatus as recited in claim 17 or 18, wherein the first section is deformable.

20. (Withdrawn) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle, comprising:

at least two discrete first sections that each connect to a peripheral portion of the steering wheel, and

a discrete rigid, semi-rigid or flexible, or non-deformable second section that connects to, and extends from each first section at a peripheral portion of the steering wheel, each second section extends from the first section outward at an angle to a plane across a front face of the steering wheel, each second section for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

21. (Withdrawn) The apparatus as recited in claim 20, wherein the steering wheel includes a steering wheel for controlling at least a nautical vessel, aircraft or ground transportation vehicle.

22. (Withdrawn) The apparatus as recited in claim 20, wherein the portion of the body supported by the second section includes at least a forearm, wrist, or hand.

23. (Withdrawn) The apparatus as recited in claim 20, wherein the apparatus is adjustable for supporting different sizes or types of body portions.

24. (Previously Presented) The apparatus as recited in claim 14, wherein each first section is formed integral with the steering wheel.

25. (Withdrawn) The apparatus as recited in claim 14 or 20, wherein each first section is detachable from the steering wheel.

26. (Withdrawn) The apparatus as recited in claim 20, wherein each first section is deformable.

27. (Previously Presented) The apparatus as recited in claim 14, wherein the first section is flexible, rigid, or semi-rigid, or non-deformable.

28. (Withdrawn) The apparatus as recited in claim 20, wherein the first section is flexible, rigid, or semi-rigid, or non-deformable.

REMARKS/ARGUMENTS

I. INTRODUCTION

Applicant would like to thank Examiner Luong for the telephonic interview (“Interview”) conducted on May 17, 2010. In the Interview, Examiner Luong and the Undersigned reached agreement regarding the amendment to the Specification as set forth herein to traverse the Examiner’s objection to the Specification. The Examiner and the Undersigned, however, did not discuss the merits of the Examiner’s anticipation rejection under 35 U.S.C. §102 based on JP-H04-78769 to Shigeru (“Shigeru”). Applicant will address in detail herein the objection to the Specification and the basis of rejection advanced by the Examiner.

Claims 14-19, 24, and 27 are pending in the present application. Of these claims, claim 14 is an independent claim and claims 15-19, 24, and 27 are dependent claims. This Amendment is being filed to respond to the Office Action dated May 13, 2000. In the Office Action, the Examiner has referred to claim 25/14 in his rejections. However, in the section titled "IN THE CLAIMS," it is noted that claim 25 has been withdrawn. Accordingly, Applicant will not respond to the Examiner's rejection as it applies to claim 25/14.

In the Office Action, the Examiner set forth the following objection to the Specification and rejection related to the claims:

A. The Specification was objected to for failing to provide a proper antecedent basis for the claimed subject matter, such as, “an upper one-half (½)” in claim 14; and

B. Claims 14-19, 24, and 27 are rejected under 35 U.S.C. § 102(b) for anticipation based on based on JP-H04-78769 to Shigeru (“Shigeru”).

Applicant will demonstrate that the Specification and claims as presented herein overcome the objection and the basis of rejection advanced by the Examiner, thereby, placing in the present application in condition for allowance.

II. LEGAL STANDARD

As stated in Section I, the Examiner has rejected claim claims 14-19, 24, and 27 for anticipation under 35 U.S.C. § 102(b) for anticipation based on Shigeru. The standard for sustaining a rejection for anticipation is a single prior art reference must disclose each and every limitation of the claim. *See, e.g., Schering Corp. v. Geneva Pharma., Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003) (“[a] patent [claim] is invalid for anticipation if a single prior art reference discloses each and every limitation of the claimed invention”); *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001) (“[t]o anticipate, every limitation of the claimed invention must be found in a single prior art reference, arranged as in a claim”); *Kloster Speedsteel AB v. Crucible, Inc.*, 794 F.2d 1565, 1571 (Fed. Cir. 1986) (“absent from the reference of any claimed element negates anticipation”). Shigeru does not meet this standard.

III. THE OBJECTION TO THE SPECIFICATION IS TRAVERSED

In the Office Action at page 2, the Examiner objected to the specification for failing to provide a proper antecedent basis for the term “an upper one-half (½).” In this Amendment, Applicant has amended paragraphs [0019] and [0025] to provide written support for what is shown in Figures 1 and 2 as filed. In the Interview with Examiner Luong on May 17, 2010, the Examiner acknowledged that Figures 1 and 2 showed the disposition of the present invention at the 10 o’clock and 2 o’clock positions, and that these positions were disposed on the upper one-half (½) of the steering control 105 and 211, respectively. Accordingly, the amendments to paragraphs [0019] and [0025] were supported by Figures 1 and 2 in the application as filed and such amendments do not add new matter.

The amendments to paragraphs [0019] and [0025] traverse the Examiner’s objection to Specification. Noting this, it is requested that the examiner withdraw this objection.

IV. CLAIMS 14-19, 24, AND 27 ARE NOT ANTICIPATED BY SHIGERU

The Examiner rejected claims 14-19, 24, and 27 under 35 U.S.C. § 102(b) for anticipation based on Shigeru. The Examiner provided a translation of Shigeru with the Office Action. The Examiner has relied on the four pages of the translation to support the anticipation

rejection raised against claims 14-19, 24, and 27. Applicant submits that Shigeru (1) teaches away from the present invention and (2) does not anticipate the present invention as the Examiner contends.

A review of the Shigeru translation teaches a support 1 that extends outward from the outer peripheral edge of a steering wheel and parallel to a plane across the face of steering wheel. Support 1 is a shaped and positioned for safety reasons to have no portion extend outward from a plane across the face of the steering wheel toward the driver; however, since support 1 is wider than the steering wheel, a portion of its width is behind the plane across the back of the steering.

The support 1 is constructed of the molded plastic that is covered with a layer of cushion material. The surface of the cushion material is then covered with cloth or leather. The driver's hands rest on the top of each support 1 at the outside perimeter of the steering wheel.

Each support 1 is fixedly attached to metal grooves cut at the outside periphery of the steering wheel. A latching mechanism extends through each support 1 so that when the support is positioned in the desired location along a metal groove, the latching mechanism is tightened to lock or fix the support in place. Once the support is fixed in place, it does not move until the latching mechanism is actuated to unlock it. In a second embodiment, instead of a groove being used, each support is fixed in place with a lever or nut using a band or U-shaped metal fitting, respectively. In each case, the support is fixed in place and in order to move it, the support must be unlatched, moved, and then latched such that is fixed to the steering wheel at the new location.

The underlying molded plastic structure of support 1 is made from a light-weight plastic. This light-weight plastic is a rigid material. In order to protect a driver from contacting this rigid structure in an accident, the support is specifically placed such that the driver would come in contact with the steering wheel before the support. To the extent that the driver comes in contact with the support in normal use, the driver would contact the cloth or leather covering the cushion material, which reduces slippage. The following from pages 2-4 of the Shigeru translation supports Applicant's understanding of this reference:

II. Scope of the Patent Claims

1. An invention of support 1 wherein support 1 can be moved along a fixing groove of steering wheel 2 and end fixed to a free place by the action of

lever 5 and metal fitting 6 to make the hands stable by fixing support 1 to the outer periphery of steering wheel 2 and reduce fatigue of driver's hands.

2. A support 1 fixed to steering wheel 2 with band 11 or U-shaped metal fitting 12 wherein a fixing groove 3 of the steering wheel is not needed to fasten support 1 from the outside of steering wheel 2.

III. Detailed Description of the Invention

Groove 3 for metal fitting 6 is cut in a conventional steering wheel, *metal fitting 6 of support 1 is fit into it in order to slide support 1 along the outer periphery of the steering wheel, and lever 5 is set into groove 7 of the support at the most preferable position of the driver's hands. When a driver wants to change the position, he/she can pull lever 5 horizontally to release the fixing, and then can move the lever to another place and fix it...*

Claim 2 is a method that is different with respect to the fixing method of support 1 wherein support 1 is fastened to the steering wheel 2 from the outside with a lever or a nut using a banned 11 or U-shaped metal fitting 12.

In the internal structure of support 1, molded part 8 is a light-weight plastic and relieves fatigue of a portion of the hands in contact with the cushion material thereon by covering the hands. A surface material 10 can be made with a cloth or with leather in order to reduce slippage of the hands as much as possible as shown in Fig. 3. *Support 1 does not come in contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.* [Emphasis Added.]

Examiner provided an Appendix with the Office Action in which he marked-up Figures 1, 2 and 4 of Shigeru to attempt to show the features of the present invention. Applicant contends that these figures along with the remainder of the figures clearly show Shigeru (1) teaches away from the present invention, and (2) does not teach or suggest the present invention for the same reasons the Board of Patent Appeals and Interferences ("Board") found in its decision dated August 31, 2009 that the present invention was not anticipated by U.S. Patent No. 2,118,540 to Van Arsdel ("Van Arsdel") or U.S. Patent No. 1,575,828 to Laubach (Laubach").¹

Initially, it is noted in Figures 1 and 4 of Shigeru that support 1 extend outward from the outer edge of the periphery of the steering wheel parallel to a plane across the face of the steering wheel and because support 1 is thicker than the steering wheel, a portion of support 1 protrudes

¹ The decision of the Board of Patent Appeals and Interferences dated August 31, 2009 is attached as Attachment 1.

behind a plane across the back of the steering wheel. No portion of support 1 extends in front of a plane across the face the steering wheel for safety reasons. This is supported at pages 3-4 of the Shigeru translation, where it states:

Support 1 does not come into contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of the steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.

As demonstrated in the quotations above from Shigeru, support 1 extends outward in the plane of the steering wheel with a portion behind that plane. Further, as a safety factor, support 1 never extends in front of the plane across the face of the steering wheel toward the driver. Therefore, noting these features of Shigeru, this reference teaches away from the present invention as claimed in independent claim 14 in which the fatigue relieving/preventing apparatus extends outward from the steering wheel toward the driver.

Claims 15-19, 24, and 27 depend from claim 14. Since claims 15-19, 24, and 27 depend from claim 14, each these dependent claims includes all the features of claim 14. Further, Given this, Shigeru teaches away from claims 15-19, 24, and 27 for the same reasons that it teaches away from independent claim 14 from which each of these dependent claims depend.

A review of Shigeru also supports that this reference does not teach or suggest at least the following feature of independent claim 14 of the present application:

the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

As noted previously, Applicant submits that support 1 of Shigeru, although being constructed of a light-weight plastic, is a rigid structure that is fixed to the steering wheel and is not "deformable out interference with vehicular operator's ability to operate the steering wheel" as set forth in claim 14. Applicant further submits, given the rigid structure of support 1 and its

fixing to the steering wheel by either (1) lever 5 with metal fitting 6 disposed in groove 7, or (2) a lever and band 11, or (3) a nut and U-shaped metal fitting 12, it is cumulative with Van Arsdel and Laubach, and, as such, independent claim 14 is patentable over Shigeru.

In overturning the Examiner's anticipation rejection under 35 USC §102 based on Van Arsdel and Laubach, the Board stated the following regarding these two references. First, with regard to Van Arsdel, the Board stated:

Van Arsdel

15. The Examiner finds from Van Arsdel's disclosure (Van Arsdel, p. 1, right column, l. 49 to p. 2, left column, l. 2 and ll. 28-32) that the grip-rest 2 is adjustable. Lines 28-32 explain that loosening or reversing the screw 14 sufficiently permits the grip-rest 2 to shift position. From this disclosure, the Examiner finds the grip-rest 2 could be placed at a position where it does not interfere with the operation of the steering wheel (*see* Ans. 11-12). As such, the Examiner finds that Van Arsdel's grip-rest 2 has the capability of deforming out of interference with the vehicular operator's body when the pressure from the vehicular operator's body is equal to or greater than the pressure needed to deform the second section out of interference. *Id.*
16. The Appellant argues that the portion of Van Arsdel's disclosure that the Examiner is using (Van Arsdel, p. 2, left column, ll. 28-32) to find that an Arsdel's grip-rest 2 is deformable does not in fact support the Examiner's finding. Instead, this portion of Van Arsdel supports a finding that to move the grip-rest 2, the screw 14 must be loosened, the rest repositioned, and screw 14 tightened. The Appellant argues that this operation is not deforming according to claim 20 [*sic.*] during normal use of the second section (grip-rest) (parenthetical nomenclature to Van Arsdel). The Appellant argues, instead, once positioned, the grip-rest is fixed. App. Br. 11.

(Board Decision, pp. 10-11)

Anticipation with Van Arsdel

We conclude that Appellant has met his burden in showing that Van Arsdel's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. *As the Appellant has stated, Van Arsdel's second section (grip rest) needs to be repositioned in order to*

be moved to a position out of interference with a driver's ability to steer the steering wheel (Fact 16) and parts of the second section (the flanges 4 and 5) give the driver something to push against to steer the car around corners and curves (Fact 17). A structure, as the Examiner has found, see Fact 15, that requires disassembly and reassembly, and permits the driver to push against cannot reasonably be considered a structure that is capable of deforming out of interference as has been claimed. Accordingly, Appellant has met his burden in showing that Van Arsdel's structure is not capable of performing the deformation out of interference function claimed. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27. [Emphasis Added.]

(Board Decision, p. 18)

Now, with respect to Laubach, the Board stated:

21. The Examiner finds that portion 10 is capable of deforming out of interference because the driver can unscrew Laubach's knobs and move them to another position as desired by the driver. Ans. 14.
22. The Appellant argues that:

The description of the knobs and a review of the Figures... [make] plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel as does the second section of claim 14. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Therefore, Laubach does not support a prima facie basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with the operation of the steering wheel in the normal operation of the knobs. [Emphasis in original.]

App. Br. 15.

(Board Decision, pp. 13-14)

Anticipation with Laubach

We conclude that Appellant has met his burden in showing that Laubach's second section does not inherently possess the characteristic of being capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As Appellant argues, in the manner in which the Examiner has utilized Laubach in order to reach the deforming out of interference function, the knobs need to be disassembled and reassembled in order to be repositioned. See Facts 21 and 22. We agree with Appellant that the disassembly and reassembly of the knobs demonstrates that the knobs are fixed and the only manner of movement to the knobs, short of disassembly, would be destructive in nature to Laubach's device. As such, to find that the functional limitation of the second section deforming out of interference, as set forth in claim 14, is inherently satisfied on a manner of movement that either requires disassembly and reassembly or is destructive is unreasonable. Accordingly, the Appellant has met his burden in showing that Laubach does not possess the capability of deforming as set forth in the claims. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14, 18, and 19/18. [Emphasis Added.]
(Board Decision, p. 20)

In the citations to the Board Decision above, it is plain that a structure in which a rigid support is fixed to the steering wheel and can only be repositioned by detaching the rigid structure and reattaching it at a different location does not anticipate claim 14 of the present invention. Applicant submits that Shigeru is like Van Arsdell and Laubach in this regard and, therefore, does not anticipate claim 14.

For convenience, Applicant again provides the following portion of the Shigeru translation (Shigeru, pp. 2-4):

II. Scope of the Patent Claims

1. An invention of support 1 wherein *support 1 can be moved along a fixing groove of steering wheel 2 and fixed to a free place by the action of lever 5 and metal fitting 6 to make the hands of stable by fixing support 1 to the outer periphery of steering wheel 2* and reduce fatigue of driver's hands.

2. A support 1 fixed to steering wheel 2 with band 11 or U-shaped metal fitting 12 wherein a fixing groove 3 of the steering wheel is not needed to fasten support 1 from the outside of steering wheel 2.

III. Detailed Description of the Invention

Groove 3 for metal fitting 6 is cut in a conventional steering wheel, *metal fitting 6 of support 1 is fit into it in order to slide support 1 along the outer periphery of the steering wheel, and lever 5 is set into groove 7 of the support at the most preferable position of the driver's hands. When a driver wants to change the position, he/she can pull lever 5 horizontally to release the fixing, and then can move the lever to another place and fix it. When the driver thinks that the change is unnecessary, he/she draws the lever 5 to the upper part of steering wheel 2 having a metal fitting inlet/outlet 4 to make it possible to freely remove the metal fitting.*

Claim 2 is a method that is different with respect to the fixing method of support 1 wherein support 1 is fastened to the steering wheel 2 from the outside with a lever or a nut using a banned 11 or U-shaped metal fitting 12.

In the internal structure of support 1, molded part 8 is a light-weight plastic and relieves fatigue of a portion of the hands in contact with the cushion material thereon by covering the hands. A surface material 10 can be made with a cloth or with leather in order to reduce slippage of the hands as much as possible as shown in Fig. 3. *Support 1 does not come in contact with the body earlier than steering wheel 2 in a collision due to an accident happening in front of steering wheel 2; almost all of the parts are formed into curved surfaces and are covered all over with flexible cushion 9 when they are fixed to steering wheel 2. Therefore, the safety of the human body is thought to be high.*
[Emphasis Added.]

Applicant's contention molded part 8 of light-weight plastic as shown in Figure 3 of Shigeru is a rigid structure is supported by the translation. Figure 3 shows molded part 8 covered with cushion material 9 and cloth or leather covering 10. Molded part 8 also includes groove 7 into which lever 5 is set. Lever 5 and metal fitting 6 are connected by a connecting rod (Figure 6.

When the driver fixes molded part 8 to the steering wheel, the connecting rod between lever 5 and metal fitting 6 is disposed through the hole in molded part 8 that extends from groove 7 to the inside surface of molded part 8. In order to fix molded part 8 to the steering wheel, there must be considerable fixing tension applied using lever 5 and metal fittings 6. If molded part 8 was not made of a rigid material, support 1 (1) would collapse under this fixing tension and (2) would not be fixed in place and not moveable from that place until the fixing tension was removed as specified in the translation. Further, the translation is explicit that in order to move support 1 from one place to another, it must be unfixed, moved, and refixed to the

steering wheel by operation of lever 5, metal fitting 6, and groove 7. As such, support 1 is a rigid structure covered with cushion material and cloth or leather.

The rigid support structure and method of moving it as disclosed in Shigeru is exactly what the Board has held is not “deforming out of interference with the vehicular operator’s ability to operate the steering wheel when pressure from the portion of the vehicular operator’s body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator’s ability to operate the steering wheel” according to claim 14 of the present invention in its holding that neither Van Arsdel nor Laubach anticipated this claim. Accordingly, it is improper for the Examiner to disregard the Board’s explicit prior holding on this issue.

Noting the foregoing, Applicant has provided at least two grounds that clearly show that Shigeru does not anticipate independent claim 14 of the present application. The first is Shigeru teaches away from the invention of claim 14, and the second is Shigeru does not anticipate claim 14 for the same reasons that the Board found Van Arsdel and Laubach do not anticipate this claim.

Claims 15-19, 24, and 27 depend from claim 14. Since claims 15-19, 24, and 27 depend from claim 14, each of these dependent claims include all the features of claim 14. Given this, Shigeru fails to anticipate claims 15-19, 24, and 27 for the same reasons that it fails to anticipate independent claim 14 from which each of these dependent claims depend.

Applicant’s positions above make plain that he has traversed the Examiner’s anticipation rejection raised against claims 14-19, 24, 27 based on Shigeru and Applicant requests that this rejection be withdrawn.

V. CONCLUSION

Claims 14-19, 24, and 27 are pending in the present application. In the May 13, 2010 Office Action, the Examiner objected to the Specification and rejected claims 14-19, 24, and 27 under 35 U.S.C. § 102(b) for anticipation based on Shigeru. Herein, Applicant has traversed the objection and rejection advanced by the Examiner. Accordingly, Applicant requests that the

objection to the Specification and anticipation rejection be withdrawn. Noting this, the present application is condition for allowance.

The present invention is new, not obvious, and useful. Reconsideration and allow of the claims are respectfully requested and the application be passed issue in due course.

Applicant has also filed a Notice of Appeal and the appropriate filing fee.

Applicant believes no other fee is due for this Amendment. However, if a fee is due, please charge our Deposit Account No. 08-0219, under Order No.: 0114089.121US1 from which the undersigned is authorized to draw.

Respectfully submitted,

Dated: May 20, 2010

/Wayne M. Kennard
Wayne M. Kennard
Registration No.: 30,271
Attorney for Applicant(s)

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, Massachusetts 02109
617-526-6000 (telephone)
617-526-5000 (facsimile)

ATTACHMENT 1



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727.306	12/03/2003	Douglas B. Wilson	114089.121	5202
23483	7590	09/02/2009	EXAMINER	
WILMERHALE/BOSTON			LUONG, VINH	
60 STATE STREET			ART UNIT	PAPER NUMBER
BOSTON, MA 02109			3656	
			NOTIFICATION DATE	DELIVERY MODE
			09/02/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

michael.mathewson@wilmerhale.com
teresa.carvalho@wilmerhale.com
sharon.mathews@wilmerhale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS B. WILSON

Appeal 2009-001868
Application 10/727,306
Technology Center 3600

Decided: August 31, 2009

Before LINDA E. HORNER, JOHN C. KERINS, and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Douglas B. Wilson (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 14-19, 24, and 27. Claims 1-13 are canceled. Claims 20-23, 25, 26, and 28 are withdrawn. We have jurisdiction under 35 U.S.C. § 6(b) (2002). An oral hearing with Appellant's counsel occurred on August 13, 2009.

THE INVENTION

The invention is to a hand and arm rest or support that prevents or lessens the amount of fatigue that occurs in the hand and arms from driving or steering a vehicle or vessel over an extended period.

Claim 14, reproduced below, is representative of the subject matter on appeal.

14. A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle, comprising:
a first section that connects to a peripheral portion of the steering wheel; and
a rigid, semi-rigid or flexible, or non-deformable¹ second section that connects to, and

¹ At the oral hearing, Appellant's counsel referred to "non-deformable" as "deformable." When questioned, Appellant's counsel stated that the claims were amended during prosecution to replace "non-deformable" with "deformable." See Transcript of Oral Hearing conducted on August 13, 2009, page 5, line 10 to page 7, line 18. A review of the prosecution history does not reveal that the Office entered such an amendment. We will take Appellant's counsel's word at the hearing that the claim term "rigid, semi-rigid or flexible, or non-deformable" should be read as "rigid, semi-rigid or flexible, or deformable." Such a reading provides consistency with the other claim limitations. Further prosecution before the Examiner should include

extends from the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a front face of the steering wheel, the second section for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and *deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.*

(App. Br. Claims Appendix) (emphasis added.)

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Laubach	US 1,575,848	Mar. 9, 1926
Van Arsdell	US 2,118,540	May 24, 1938
Anson	US 2,134,020	Oct. 25, 1938

an amendment to comport with Appellant's counsel's statements made during the oral hearing. Note that the term "non-deformable" appears throughout the Specification.

THE REJECTIONS

The Examiner made the following final rejections:

A) Claims 14-19, 24, and 27 are rejected under 35 U.S.C. § 112, second paragraph.

B) Claims 14-17, 19/17, 24, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Van Arsdell.

C) Claims 14-17, 19/17, 24, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Anson.

D) Claims 14, 18, and 19/18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Laubach.

E) Claims 14-19, 24, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-28 of copending patent Application No. 10/720,821.

SUMMARY OF DECISION

We AFFIRM.

ISSUES

1) Whether the Appellant has demonstrated error in the Examiner's provisional rejection of claims 14-19, 24, and 27 under the judicially created doctrine of obviousness-type double patenting over claims 20-28 of copending patent Application No. 10/720,821.

2) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14-19, 24, and 27 under 35 U.S.C. § 112, second paragraph.

3) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27 as being anticipated by Van Arsdel. This issue turns on whether the Appellant has shown that the Examiner erred in finding that, because Van Arsdel explicitly discloses that the driver may remove and then reattach the grip rest in another location, this operation reads on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

4) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27 as being anticipated by Anson. This issue turns on whether the Appellant has shown that the Examiner erred in finding that Anson's explicit disclosure that the grip portion being made from a pliable and semi-rigid material permits this structure to read on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel, when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

5) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14, 18, and 19/18 as being anticipated by Laubach. This issue turns on whether the Appellant has shown that the Examiner erred in finding that, because a vehicle operator could unscrew Laubach's knobs and fasten the knobs to another position, this permits this structure to read on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Facts pertinent to the Provisional Obviousness-Type Double Patenting rejection

1. The Notice of Appeal is silent as to the specific claims being appealed. *See* Notice of Appeal received Dec. 6, 2007.
2. The Appeal Brief clearly states that all of the finally rejected claims, claims 14-19, 24, and 27 are the subject of the appeal. App. Br. 1.

3. The Appeal Brief omits the provisional rejection under the judicially-created doctrine of obviousness-type double patenting in the grounds of rejection to be reviewed on appeal. App. Br. 6.
4. The Appeal Brief does not present arguments rebutting the provisional rejection under the judicially-created doctrine of obviousness-type double patenting. App. Br., *passim*.
5. The Examiner maintains the provisional rejection under the judicially-created doctrine of obviousness-type double patenting. Ans. 7-8.
6. In the Reply Brief, the Appellant recognizes that the Examiner maintains the provisional rejection under the judicially-created doctrine of obviousness-type double patenting, and the Appellant does not argue the Examiner erred in making the rejection. Reply Br. 1 and 2.

Facts pertinent to the 35 U.S.C. § 112, second paragraph, rejection

7. The Examiner reasons that the terms “rigid,” “semi-rigid,” “flexible,” and “non-deformable” are indefinite because the disclosure does not provide a standard to ascertain the requisite degree. Ans. 3-4.
8. Appellant provides, as evidence, excerpts from a standard dictionary to illustrate that these terms are common and have widely accepted meanings, and further, the Appellant states that he has not given any special meaning to these terms. App. Br. 8-9.
9. The Examiner responds to the Appellant’s evidence and argument by citing to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) and then states that *Phillips* stands for the proposition that the

Specification is the single best guide to determining the meaning of a claim term. As such, the Examiner posited that because the Specification does not provide guidance as to what type of materials are considered to be “rigid, semi-rigid, or flexible, or non-deformable” this makes these claim terms unclear and/or ambiguous. Ans. 9-10.

10. Appellant urges that *Phillips*, 415 F.3d at 1314, supports his position because dictionary definitions are appropriate evidence to show the widely accepted meaning of commonly understood words. Reply. Br. 5.

Facts pertinent to the anticipation rejections

11. The Appellant does not contest the Examiner’s finding that each of Van Arsdel, Anson, and Laubach discloses a first section that connects to a peripheral portion of a steering wheel. App. Br. and Reply Br., *passim*.
12. The Appellant does not contest the Examiner’s finding that each of Van Arsdel, Anson, and Laubach discloses a second section that connects to, and extends from, the first section. App. Br. and Reply Br., *passim*.
13. The Appellant does not contest the Examiner’s finding that Anson’s and Laubach’s second section is for supporting a portion of a vehicular operator’s body when pressure from the operator’s body portion is less than the pressure needed to deform the second section. App. Br. and Reply Br., *passim*. Van Arsdel’s objective is to provide

a second section (grip-rest 2)² to an automobile steering wheel which will support the thumb and fingers and keep the hand in a proper steering position (comfortable for his thumb and fingers and which will keep the hand in a proper steering position). (Van Arsdel, p. 1, left column, ll. 1-5). Additionally, Van Arsdel discloses that:

The weight of the hand and arm are comfortably supported with the bottom of the hand resting in the concavity of the grip-rest ... or with the ball of the thumb seated in the concavity as shown [in the figure] ... and the two optional positions afford opportunity for change which will keep the hand and arm from the cramp or strain from long driving.

(Van Arsdel, p. 1, right column, ll. 41-48). A device that has as its objective and is disclosed to comfortably support the hand and arm would not deform under the pressure that is needed to deform such a device. As such, we find that Van Arsdel explicitly discloses that its second section (grip-rest 2) is for supporting a portion of a vehicular operator's body when pressure from the operator's body portion is less than the pressure needed to deform the second section.

14. As such, we find that each of Van Arsdel, Anson, and Laubach, explicitly discloses:

A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising: a first section that connects to a peripheral portion of the steering wheel; and a... second section that connects to, and extends from the first section at the peripheral portion of the steering wheel, ... the second section for

² Parenthetical nomenclature, Van Arsdel.

supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel . . .

See Claim 14, supra.

Van Arsdel

15. The Examiner finds from Van Arsdel's disclosure (Van Arsdel, p. 1, right column, l. 49 to p. 2, left column, l. 2 and ll. 28-32) that the grip-rest 2 is adjustable. Lines 28-32 explain that loosening or reversing the screw 14 sufficiently permits the grip-rest 2 to shift position. From this disclosure, the Examiner finds that the grip-rest 2 could be placed at a position where it does not interfere with the operation of the steering wheel (*see* Ans. 11-12). As such, the Examiner finds that Van Arsdel's grip-rest 2 has the capability of deforming out of interference with the vehicular operator's body when the pressure from the vehicular operator's body is equal to or greater than the pressure needed to deform the second section out of interference. *Id.*
16. The Appellant argues that the portion of Van Arsdel's disclosure that the Examiner is using (Van Arsdel, p. 2, left column, ll. 28-32) to find that Van Arsdel's grip-rest 2 is deformable does not in fact support the Examiner's finding. Instead, this portion of Van Arsdel supports a finding that to move the grip-rest 2, the screw 14 must be loosened, the rest repositioned, and screw 14 tightened. The Appellant argues that this operation is not deforming according to claim 20 during

normal use of the second section (grip-rest) (parenthetical nomenclature to Van Arsdel). The Appellant argues, instead, that once positioned, the grip-rest is fixed. App. Br. 11.

17. The Appellant argues, further, that Van Arsdel's disclosure at p. 1, right column, ll. 22-28, reproduced below, supports the position that the grip-rest 2 of Van Arsdel does not deform according to claim 20 when pressure is applied to it:

These flanges 4 and 5 enable the operator instantly to feel any deviation of the car from a straight course and gives him something substantial to push against in resistance and also in rotating the wheel to steer the car around corners and curves and away from obstructions or bad places in the roadway.

App. Br. 11. *See also* Reply Br. 10.

Anson

18. The Examiner finds that Anson's grip portion 11 is constructed from a pliable and semi-rigid composition. *See* Ans. 5; Anson, p. 1, right column, ll. 5-24 and p. 2, right column, ll. 25-40. As such, the Examiner finds that Anson's steering wheel attachment is capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure applied is greater than or equal to the pressure needed to deform the attachment while the vehicular operator is operating the steering wheel. Ans. 6 and 12. An article of manufacture made from a pliable and semi-rigid composition, *e.g.*, rubber, would inherently have a capability to deform out of interference.

19. The Appellant cites to Anson, p. 1, left column, ll. 6-25 and right column, l. 49 to p. 2, left column l. 18, to counter the Examiner's findings. App. Br. 12. Appellant then argues, based on the citation and quoted Anson passages:

[W]hen the Anson handgrip is in use, it is in the pendant position below the steering wheel and is used to steer the vehicle. If, during normal operations, the driver were to grab the steering wheel in an emergency situation, he would release the handgrip and grab the wheel, for example, at the 10 and 2 o'clock positions. In doing so, the pendant-hanging handgrip would not be deformed as set forth in claim 14 because it would not be in use at all.

App. Br. 13.

20. In responding to the Examiner's finding that movement of the steering wheel attachment provides further reason to find that the attachment is capable of deforming out of interference, the Appellant argues:

When the handgrip is moved to the top, it is moved there to be placed purposefully out of use all the time... If the handgrip is moved to the top of the steering wheel, as suggested by the Examiner, it would be awkward and dangerous to use for driving because the driver's hands would be disposed through the steering wheel.

App. Br. 14.

In this position, it also would not provide any of the benefits recited in Anson to relieve fatigue in the arms and hands of the driver.

App. Br. 13.

In order to move the handgrip, it would be understood that the vehicle would have to be stopped, the handgrip detached and repositioned at the top, and reattached.

App. Br. 14.

Laubach

21. The Examiner finds that portion 10 is capable of deforming out of interference because the driver can unscrew Laubach's knobs and move them to another position as desired by the driver. Ans. 14.
22. The Appellant argues that:

The description of the knobs and a review of the Figures makes plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel as does the second section of claim 14. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Therefore, Laubach does not support a prima facie basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with

the operation of the steering wheel in the normal
operation of the knobs.

App. Br. 15.

PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“[t]o reject claims in an application under section 103, an examiner must show an unrebutted *prima facie* case of obviousness.... On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

“A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

... where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

ANALYSIS

Issue (1)

Appellant's Notice of Appeal is silent as to the specific claims being appealed. Fact 1. The Appeal Brief clearly states that all of the finally rejected claims are the subject of the appeal. Fact 2. In the grounds of rejection under review, the Appeal Brief omits the provisional rejection under the judicially-created doctrine of obviousness-type double patenting. Fact 3. The Appeal Brief does not separately argue that ground of rejection. Fact 4. The Examiner maintains the provisional rejection. Fact 5. Appellant does not address the provisional rejection in the Reply Brief. Fact 6. As such, Appellant has not met his burden of demonstrating error in the Examiner's position. See *Kahn*, 441 F.3d at 985-86. Therefore, with the

Examiner maintaining the rejection, the Notice of Appeal being silent as to specific claims being appealed, the Appeal Brief clearly stating that all finally rejected claims are the subject of the appeal, and no arguments made to demonstrate error in the Examiner's position within the Appeal Brief or Reply Brief, we summarily sustain the provisional obviousness-type double patenting rejection.

Issue (2)

As Appellant has pointed out, the claim term "rigid, semi-rigid or flexible, or non-deformable" is "readily apparent even to lay judges, and [this] claim construction ... involves little more than the application of the widely accepted meaning of commonly understood words." *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). Appellant's use of the standard dictionary is not for construing the claim, but as evidence to demonstrate how a person of ordinary skill in the art would interpret this claim term when the claim term was read in light of the Specification. Facts 8 and 10. In this case, the claims recite all of the possible permutations of hardness of the second section. So, a person having ordinary skill in the art would be able to understand the scope of the claim, because it covers a second section of virtually any hardness. As such, we are constrained to not sustain this rejection.

Issues (3), (4), and (5)

Appellant does not separately argue the claims in each ground of rejection. *See* App. Br. 9-16. We select independent claim 14 as the representative claim for deciding whether the Appellant has demonstrated

error in the rejections set forth by the Examiner. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008). Accordingly, the dependent claims also rejected under each ground of rejection will stand or fall with claim 14 for each rejection.

We find that the prior art used by the Examiner explicitly discloses a fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising a first section that connects to a peripheral portion of the steering wheel, and a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, where the second section is for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. *See* Facts 11-14.

The issue becomes whether the Appellant has shown error in the Examiner's finding that structures explicitly described in the prior art can satisfy the functional aspect of the second section being able to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. Below we address whether the Appellant has shown error in the Examiner's rejection with respect to this issue for each piece of prior art.

Anticipation with Van Arsdel

We conclude that Appellant has met his burden in showing that Van Arsdel's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As the Appellant has stated, Van Arsdel's second section (grip rest) needs to be repositioned in order to be moved to a position out of interference with a driver's ability to steer the steering wheel (Fact 16), and parts of the second section (the flanges 4 and 5) give the driver something to push against to steer the car around corners and curves (Fact 17). A structure, as the Examiner has found (*see* Fact 15), that requires disassembly and reassembly, and permits the driver to push against it cannot reasonably be considered a structure that is capable of deforming out of interference as has been claimed. Accordingly, Appellant has met his burden in showing that Van Arsdel's structure is not capable of performing the deformation out of interference function claimed. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27.

Anticipation with Anson

We conclude that Appellant has not met his burden in showing that Anson's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of

interference with the vehicular operator's ability to operate the steering wheel. The Examiner has clearly found that Anson prefers to use a pliable and semi-rigid composition to form the grip portion 11 that the Examiner is utilizing to read on the second structural aspect. *See* Fact 18. An article of manufacture made from a pliable and semi-rigid composition, *e.g.*, rubber, would inherently have a capability to deform out of interference. *See id.* The amount of deformation out of interference would be dependent upon the resilience property of the cured rubber and not its form. Appellant tries to show that Anson does not inherently possess the characteristic of deforming out of interference because the grip would either not be used in operation (Fact 19), would be dangerous to operate, or would not achieve the recited benefits (Fact 20). Neither argument outweighs the explicit disclosure that Anson's device is manufactured from a material that is pliable and semi-rigid and thus would have an inherent property of being deformable.

In this case, the Examiner has good reason (Fact 18) to believe that the functional limitation (deforming out of interference) asserted to be critical in establishing novelty in the claimed subject matter, is, in fact, an inherent characteristic of Anson's steering attachment. In such a case, the Appellant must provide evidence that Anson's steering attachment is not capable of deforming out of interference. *See Swinehart*, 439 F.2d at 213. Arguments that focus on a particular envisioned use of a device in a particular driving condition is not evidence that the device is not inherently capable of deforming out of interference. As such, Appellant has not met his burden of showing that Anson's steering attachment is not capable of

deforming out of interference as set forth in claim 14. Claims 15-17, 19/17, 24, and 27 fall with claim 14.

Anticipation with Laubach

We conclude that Appellant has met his burden in showing that Laubach's second section does not inherently possess the characteristic of being capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As Appellant argues, in the manner in which the Examiner has utilized Laubach in order to reach the deforming out of interference function, the knobs need to be disassembled and reassembled in order to be repositioned. *See* Facts 21 and 22. We agree with Appellant that the disassembly and reassembly of the knobs demonstrates that the knobs are fixed and the only manner of movement to the knobs, short of disassembly, would be destructive in nature to Laubach's device. As such, to find that the functional limitation of the second section deforming out of interference, as set forth in claim 14, is inherently satisfied on a manner of movement that either requires disassembly and reassembly or is destructive is unreasonable. Accordingly, the Appellant has met his burden in showing that Laubach does not possess the capability of deforming as set forth in claims. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14, 18, and 19/18.

CONCLUSIONS

Appellant has not met his burden of demonstrating error in the Examiner's position rejecting the appealed claims under the judicially created doctrine of obviousness-type double patenting.

Appellant has met his burden of demonstrating error in the Examiner's conclusion that the appealed claims are indefinite.

Appellant has met his burden of showing that the structures in Van Arsdell and Laubach are not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

Appellant has not met his burden of showing that the steering wheel attachment disclosed in Anson is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

DECISION

The Examiner's decision to provisionally reject claims 14-19, 24, and 27 under the judicially-created doctrine of obviousness-type double

Appeal 2009-001868
Application 10/727,306

patenting as being unpatentable over claims 20-28 of copending patent Application No. 10/720,821 is summarily affirmed.

The Examiner's decision to reject claims 14-19, 24, and 27 under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner's decision to reject claims 14-17, 19/17, 24, and 27 as being anticipated by Van Arsdell is reversed.

The Examiner's decision to reject claims 14-17, 19/17, 24, and 27 as being anticipated by Anson is affirmed.

The Examiner's decision to reject claims 14, 18, and 19/18 as being anticipated by Laubach is reversed.

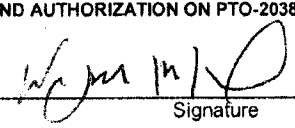
No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

mls

WILMERHALE/BOSTON
60 STATE STREET
BOSTON, MA 02109

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES		Docket Number (Optional) 0114089.00121US1
In re Application of Douglas B. WILSON		
Application Number 10/727,306-Conf. #5202		Filed December 3, 2003
For FATIGUE RELIEVING SUPPORT FOR STEERING WHEELS AND THE LIKE		
Art Unit 3656		Examiner V. Luong
<p>Applicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner.</p> <p>The fee for this Notice of Appeal is (37 CFR 41.20(b)(1)) \$ <u>540.00</u></p> <p><input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ <u>270.00</u></p> <p><input type="checkbox"/> A check in the amount of the fee is enclosed.</p> <p><input checked="" type="checkbox"/> Payment by credit card. Form PTO-2038 is attached.</p> <p><input type="checkbox"/> The Director has already been authorized to charge fees in this application to a Deposit Account.</p> <p><input checked="" type="checkbox"/> The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No. <u>08-0219</u>.</p> <p><input type="checkbox"/> A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.</p> <p>WARNING: INFORMATION ON THIS FORM MAY BECOME PUBLIC. CREDIT CARD INFORMATION SHOULD NOT BE INCLUDED ON THIS FORM. PROVIDE CREDIT CARD INFORMATION AND AUTHORIZATION ON PTO-2038.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 60%;"> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>30,271</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> </div> <div style="width: 35%; text-align: center;">  _____ Signature _____ Wayne M. Kennard Typed or printed name _____ (617) 526-6000 Telephone number _____ May 20, 2010 Date </div> </div>		

☐ *Total of 1 forms are submitted.